

REMARKS

Applicants respectfully request reconsideration of the present Application. Claims 1, 18, and 32 have been amended herein. Also, claim 15 has been canceled herein. No new matter was introduced by virtue of the amendments herein. Accordingly, claims 1-14 and 16-39 are pending and in condition for allowance.

Objections

The specification was objected to for referring to an element (112) as “a set of shared images,” “a set of shared media objects,” and “a set of users.” The Specification has been amended herein at ¶¶ 0013, 0018, and 0020, without adding new matter, to cure the stated informality.

Rejections based on 35 U.S.C. § 101

Claims 32-39 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. Claim 32 has been amended herein to recite a method claim, which is statutory subject matter under § 101.

Rejections based on 35 U.S.C. § 102(b)

Claims 1-14, 17-29, and 32-39 were rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by U.S. Patent Publication Number 2002/0126135 to Ball et al. (“Ball”). Anticipation “requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee.”¹ “[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject

¹ MPEP § 2131, *passim*; *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302 (Fed. Cir. 1995).

matter must be expressly or inherently described in a single prior art reference.”² “The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention.”³ In light of the amendments above, applicants respectfully submit that the Ball does not anticipate claims 1-14, 17-29, and 32-39 for at least the reasons set forth below.

Independent claim 1 is directed to a computer-implemented messaging system comprising, in part, a media viewer. The media viewer has been amended to recite the following functionality.

wherein the media viewer is configured to **assign two or more control objects** to two or more users of the plurality of users, wherein each of the two or more control objects is at least one of a certificate, cookie, or token and is transmissible to another user of the plurality of users such that, upon receipt of one of the two or more objects, a receiving user is permitted to:

- (1) **control the display of each of the media objects** in the set of shared media objects, and
- (2) **manipulate remote interface elements** on one or more media viewers presented to one or more users without one of the two or more control objects. (emphasis added).

Support for the above feature can be found in the Specification at ¶¶ 0018-0020. Applicants respectfully submit that Ball fails to describe the same.

At best, Ball describes communicating a file and a file controller to a server, wherein the file controller is further for storing the file.” *Ball* at ¶ 0010. Clearly, this is not the

² *Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research*, 304 F.2d 1221, 1227 (Fed. Cir. 2002) (citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988)).

³ *Id.* (emphasis added)(citing *Crown Operations Int’l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002); *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990)). *See also*, *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996).

same as the control object of claim 1 because the control object does not contribute to the storing of a file. Rather, the control object permits a receiving user to control the display of shared media objects and manipulate remote interface elements on other users' media viewers. Thus, the control object recited in claim 1, as amended herein, is not described in Ball. Moreover, claim 18 recites assigning "two or more control objects to two or more users;" whereas, Ball only discloses one file controller that is assigned to one file.

Similarly, independent claim 18, as amended herein, recites a method that includes the following feature.

assigning **two or more control objects** to two or more users of the plurality of users, wherein each of the two or more control objects is at least one of **a certificate, cookie, or token** and is transmissible to another user of the plurality of users such that, upon receipt of one of the two or more objects, a receiving user is permitted to:

- (1) **control the display** of each of the media objects in the set of shared media objects,
- (2) **manipulate remote interface elements** on one or more media viewers presented to one or more users without one of the two or more control objects. (emphasis added).

Support for the above feature can be found in the Specification at ¶¶ 0018-0020. Applicants respectfully submit that Ball fails to describe the same.

At best, Ball describes communicating a file and a file controller to a server, wherein the file controller is further for storing the file." *Ball* at ¶ 0010. Clearly, this is not the same as the control object of claim 18 because the control object does not contribute to the storing of a file. Rather, the control object permits a receiving user to control the display of shared media objects and manipulate remote interface elements on other users' media viewers. Thus, the control object recited in claim 18, as amended herein, is not described in Ball.

Moreover, claim 18 recites assigning “two or more control objects to two or more users;” whereas, Ball only discloses one file controller that is assigned to one file.

Amended claim 18 also recites “on the media viewer being presented to a user who transmitted any of the two or more control objects, graying-out one or more media-viewer controls.” As previously stated, Ball does not discuss transmitting the control objects recited in claim 18. And if Ball did describe such a feature, it certainly does not describe graying-out controls on a user’s media viewer when the user relinquishes control of a media-sharing session.

For at least the above reasons, Ball fails to anticipate claim 18, as amended herein. Accordingly, Applicants request withdrawal of the § 102(b) rejection of claim 18.

Independent claim 32 has been amended to recite, in part, “transmitting a control object from the at least one user with control to the at least one user without control.” This amended claim further recites “after the transmission: (1) allowing the user that received the control object to **manipulate remote interface elements** presented to the user that transmitted the control object, and (2) **graying-out one of more controls** presented to the user that transmitted the control object.” As previously stated, in reference to claim 18, Ball does not describe a control object that, when communicated to a user, allows the user to manipulate remote interface elements on a media viewer of the user who sent the object. Nor does Ball disclose graying-out controls on the media viewer of a user who transmitted the control object. Therefore, Ball fails to describe all of the features of claim 32 and cannot anticipate it. Accordingly, Applicants respectfully request withdrawal of the § 102(b) rejection of claim 32.

Additionally, claims 2-14, 17, 19-29, and 33-39, which depend from one of independent claims 1, 18, and 32, are submitted to be allowable, at a minimum, by virtue of their dependence from an allowable base claim.

Rejections based on 35 U.S.C. § 103(a)

Claims 15 and 30 were rejected under 35 U.S.C. § 103(a) for allegedly being obvious in light of the of Ball and McIntyre. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *See In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988); *see also*, MPEP § 2143.03. Claim 15 has been canceled herein, rendering the rejection thereto moot. Dependent claim 30 depends from independent claim 18, which, as amended herein, is not taught by Ball for the aforesaid reasons. Similarly, McIntyre fails to cure any of the above deficiencies of Ball and therefore cannot properly be used to support an obviousness rejection of claim 30. Accordingly, the § 103(a) rejections of claims 15 and 30 should be withdrawn.

Rejections based on 35 U.S.C. § 103(a)

Claims 16 and 31 were rejected under § 103(a) for allegedly being obvious in light of the of Ball. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *See In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988); *see also*, MPEP § 2143.03. Claim 16 depends from amended claim 1, which, for the reasons stated above, is not taught by Ball. Likewise, claim 31 depends from amended claim 18, which, for the reasons stated above, is also not taught by Ball. Accordingly, the § 103(a) rejections of claims 16 and 31 should be withdrawn.

CONCLUSION

For at least the reasons stated above, claims 1-14 and 16-39 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or phoeller@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

/Peter J. Hoeller/

Peter J. Hoeller
Reg. No. 61,468

PJH/bp
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550